

REMARKS

Status of Claims and Summary of Application

In the October 19, 2001 Office Action, claims 1-3, 19, 20, 22, 25 and 28-46 stand rejected under 35 U.S.C. §251 as improperly recapturing subject matter that was surrendered in the application for the patent upon which the present reissue is based. Claims 5-9, 11-17, 20, 23, 24, 26 and 27 are not rejected in view of prior art or for recapture of canceled subject matter. Claims 5-9, 11-17, 20, 23, 24, 26 and 27 were indicated as being allowed on the Office Action Summary (page 1). No prior art rejections were made in the October 19, 2001 Office Action.

This amendment amends independent claims 1, 25, 28, 37 and 46. Accordingly, after entrance of this Amendment, original patent claims 1-3, 5-9 and 11-17 and new application claims 19, 20 and 22-46 are pending for consideration and examination. Claims 4, 10, 18 and 21 have been canceled. Original patent claims 1, 5 and 11 are independent claims. Also new application claims 19, 20, 23, 25, 27, 28, 37 and 46 are independent claims. Reexamination and reconsideration of these claims are respectfully requested in view of the above-amendments and the following comments.

Explanation of Support in the Disclosure of the Patent for the Amendments

Basically, the amendments to claims 1, 25, 28, 37 and 46 removes the clarifying amendments that were enter in the April 27, 2001 Amendment. Based on an interview with Examiner Canfield, Applicant believed that an agreement was reached such that the prior amendments to claims 1, 25, 28, 37 and 46 would place them in condition for allowance. In view of the rejection, Applicant has removed these clarifying amendments that were enter in the April 27, 2001 Amendment. The attached pages that begin with the caption "**MARKED-**

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UP VERSION OF AMENDMENTS" (Pages 16-21) show the changes made to the claims by the current amendment.

Specifically, the amendments to claim 1 deletes the reference to ***vertical*** from the claims as the word refers to the ***spacer members*** that hold the first and second metal plate members in parallel relationship with each other". The amendments to claim 1 are fully supported by the patent in the specification at column 6, lines 41-51, in original independent claim 1, and in the drawings at Figures 1 and 3.

The amendments to claim 25 deletes the reference to ***vertical*** from the claims as the word refers to the ***spacer members*** that hold the first and second metal plate members in parallel relationship with each other". The amendments to claim 25 are fully supported by the patent in the specification at column 6, lines 41-51, in original independent claim 1, and in the drawings at Figures 1 and 3.

The amendments to claim 28 deletes the reference to ***vertical*** from the claims as the word refers to the ***spacer members*** that hold the first and second metal plate members in parallel relationship with each other". The amendments to claim 28 are fully supported by the patent in the specification at column 6, lines 41-51, in original independent claim 1, and in the drawings at Figures 1 and 3.

The amendments to claim 37 deletes the reference to ***vertical*** from the claims as the word refers to the ***spacer members*** that hold the first and second metal plate members in parallel relationship with each other". The amendments to claim 37 are fully supported by the patent in the specification at column 6, lines 41-51, in original independent claim 1, and in the drawings at Figures 1 and 3.

The amendments to claim 46 deletes the reference to ***vertical*** from the claims as the word refers to the ***spacer members*** that hold the first and second metal plate members in

parallel relationship with each other". The amendments to claim 46 are fully supported by the patent in the specification at column 6, lines 41-51, in original independent claim 1, and in the drawings at Figures 1 and 3.

Claim Rejection Under 35 U.S.C. §251

In paragraph 2 of the Office Action, claims 1-3, 19, 20, 22, 25 and 28-46 also stand rejected under 35 U.S.C. §251 as improperly recapturing subject matter that was surrendered in the application for the patent upon which the present reissue is based. Claims 5-9, 11-17, 23, 24, 26 and 27 were not rejected for recapturing subject matter that was surrendered. Applicant respectfully traverses this rejection and requests reconsideration of this rejection.

This reissue application was filed within two years of the issue date of U.S. Patent No. 5,649,391 ("the Layne patent"). Therefore, Applicant is permitted to broaden the scope of the claims so long as the reissue claims do not recapture subject matter, which was surrendered during prosecution of the patent, upon which this reissue application is based. The application of the Layne patent was filed with seventeen claims and was allowed without any amendment to avoid prior art or any arguments by Applicant on patentability.

However, in the September 17, 1996 Office Action, a statement was made regarding the patentability of the allowed claims. Specifically, it was stated that

The above claims overcome the prior art of record with respect to an embeddable mounting device comprising: first and second rectangular metal members separated by a pair of vertical spacer members in a manner forming a plurality of reinforcing bar and cement cavities to allow said device to fit into a concrete block wall; a plurality of vertical reinforcing bars, each with four bends, connected in fixed relationship to the interior of said mounting device plates.

Clearly, this description by the prior Examiner in examining the application that matured into the Layne patent is not commensurate in scope with independent claims 1 and

11 of the Layne patent. Therefore, Applicant respectfully submits that this Indication of Reasons for Allowance does not aid one reading the prosecution history of the Layne patent in determining why the application was allowed. Moreover, as stated in MPEP §1302.12 Reasons for Allowance may have a possible estoppel effect on the claims. However, this section of the MPEP does not state that the Reasons for Allowance shall have estoppel effects on the claims. Moreover, this section of the MPEP cautions examiners that the examiner should keep in mind that possible misinterpretations of his or her statements that *may* be made and its possible estoppel effects. Clearly, the prior Examiner who set forth the Reasons for Allowance in the September 17, 1996 Office Action failed to follow the guidelines set forth in MPEP §1302.12 in that the Examiner's Reasons for Allowance does not make the record clear to why the claims were allowed.

The recapture rule is applied when the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. See, *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), the Court of Appeals for the Federal Circuit explains how to apply the recapture rule. In applying the recapture rule, *In re Clement* states:

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims....

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an Applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. See *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984).

Moreover, the Court of Appeals for the Federal Circuit in *Hester Industries, Inc. v. Stein Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998) stated that

because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other aspects. See, e.g., *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("reissue claims that are broader in certain respects and narrower in other respects may avoid the affect of the recapture rule."); *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165. For example, in *Ball*, the recapture rule was avoided because "the reissue claims were sufficiently narrowed (described by the court as "fundamental narrowness") despite the broadening aspects of the claims, 729 F.2d at 1438, 221 USPQ at 296. In the context of a surrender by way of argument, this principle in appropriate cases may operate to overcome the recapture rule when the reissue claims are materially narrowed in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection that he is rightfully entitled for such overlooked aspects".

Since the claims of the application that matured into the Layne patent were not amended to avoid the prior art and arguments were not presented to distinguish the claims from the prior art, the only question is whether or not the Examiner's Reasons for Allowance in the September 17, 1996 Office Action should have estoppel effect to prevent broadening of the claims as currently presented.

Applicant acknowledges that arguments without amendments to the claims in the original application *may* be sufficient to establish recapture according to the decision in *Hester*. However, the facts in *Hester* are completely different from the present case. In *Hester*, arguments were made that clearly indicated what was surrendered. In contrast, the Reasons for Allowance set forth in the September 17, 1996 Office Action is so vague and indefinite as to why the claims were allowed that no estoppel effect should be given to the Examiner's Reasons for Allowance. In particular, MPEP §1412.02 does not require the application of the recapture rule in every instance where there is an Examiner's Reasons for

Allowance that was not rebutted by the applicant. In other words, the recapture rule must be applied on a case by case basis.

In the present case, Applicant believes that the removal of the modifying word *vertical* before spacer members is not an impermissible recapture. Just because the vertical limitation was mentioned in the prior Examiner's Reasons for Allowance, this does not establish that this limitation cannot be removed from the claims without violating the recapture rule. In fact, there are limitations in the prior Examiner's Reasons for Allowance that are not present in both of the independent claims. Thus, the prior Examiner's Reasons for Allowance are not clear and no estoppel effect should be given to them.

Moreover, the fact that the Applicant did not present arguments on the record to counter the Examiner's Reasons for Allowance does not in itself establish that subject matter has been surrendered by Applicant. In particular, the above-mentioned case law fails to establish that Applicant's failure to respond to an Examiner's Reasons for Allowance is dispositive of the issue of surrender of subject matter. Also the above-mentioned case law fails to establish that an Examiner's Reasons for Allowance has any estoppel effect in the application of the recapture rule. Thus, the prior Examiner's Reasons for Allowance are not no estoppel effect should be given to the prior Examiner's Reasons for Allowance.

In view of the above analysis of the recapture rule, the conclusion is inescapable that the claims in this reissue application do not recapture surrendered subject matter. Applicant respectfully submits that the rejection of claims 1-3, 19, 20, 22, 25 and 28-46 is untenable in view of the current case law. Thus, Applicant requests that this rejection be withdrawn.

Allowable Subject Matter

In paragraph 3 of the Office Action, claims 5-9, 11-17, 23, 24 and 26 were indicated as allowed. Claim 27 was indicated as allowed on the Office Action Summary (page 1), but

not in paragraph 3 of the Office Action. Applicant believes that claim 27 is allowable because it was not rejected in view of prior art or for recapture of canceled subject matter. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

Prior Art Citation

In paragraph 4 of the Office Action, U.S. Patent No. 480,700 to Pauly, Sr. was made of record as it was cited in the parent application. Applicant believes that this reference does not render the claimed invention obvious. Applicant's claimed invention is directed to a metal block that is designed to replace a ***conventional concrete block***. In other words, the metal block of the present invention is designed to be used with ***conventional concrete blocks***. Clearly, this type of metal block is not shown or disclosed by the Pauly, Sr. patent. Therefore, this reference does not render the claimed invention obvious.

Applicant believes that the dimensional relationship of the parts of the metal block of the present invention to the dimensional relationship of the parts of ***conventional concrete blocks*** is important aspect of the present invention. In other words, the dimensional relationship of the parts of the present invention relative to ***conventional concrete blocks*** should also be given patentable weight in this case. While the claims use environmental structure (***conventional concrete blocks***) to define various elements of the claims, these "environmental limitations" also should be given patentable weight and do not render the claims indefinite. In particular, the Federal Circuit in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986) has held similar language, used in claims to satisfy 35 U.S.C. § 112, second paragraph. In particular, the *Orthokinetics* case involved a patent covering a pediatric wheel chair. The claims in the *Orthokinetics* case recited background or environmental structure such as "an automobile" and various parts of

the automobile. For example, claim 1 of the patent in the *Orthokinetics* case reads as follows:

1. In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is so dimensioned as to be insertable through the space between the doorframe of an automobile and one of the seats thereof whereby said front leg is placed in support relation to the automobile and will support the seat portion from the automobile in the course of subsequent movement of the wheel chair into the automobile and the retractor means for assisting the attendant in retracting said rear wheel assembly upwardly independently of any change in the position of the front leg portion with respect to the seat portion while the front leg portion is supported on the automobile and to a position which clears the space beneath the rear end of the chair and permits the chair seat portion retracted rear wheel assembly to be swung over and set upon said automobile seat. (Emphasis added).

The Federal Circuit held that this claim complies with 35 U.S.C. § 112, second paragraph. In particular, the Federal Circuit stated:

The claims were intended to cover the use of the invention with various types of automobiles. That a particular chair on which the claims read may fit within some automobiles and not o[t]hers is of no moment. The phrase "so dimensioned" is so accurate as the subject matter permits, automobiles being of various sizes. See, Rosemont, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984). As long as those of ordinary skill in the art realized that the dimensions could be easily obtained, § 112, 2d ¶ requires nothing more. The patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims.

Therefore, the uses of environmental structure are permissible to further define structure within a claim. Therefore, Applicant believes that the claimed invention overcomes the prior art of record.

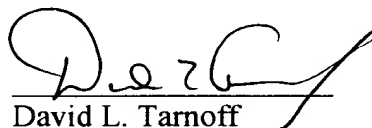
New Oath/Declaration

Since the claims of this application are being amended, Applicant submits herewith a Supplemental Reissue Declaration. Therefore, Applicant believes that this rejection has been overcome.

* * *

By the above amendments to the claims, Applicant is hereby seeking to correct an error in the issued patent. Specifically, the claims of the issued patents were overly narrow and did not adequately claim the disclosed subject matter. In view of the foregoing comments, Applicant believes that all pending claims 1-3, 5-9, 11-17, 19, 20 and 22-46 are allowable over the prior art of record and that no recapture exists. Reexamination and reconsideration of the claims are respectfully requested.

Respectfully submitted,



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MARKED-UP VERSION OF AMENDMENTS

IN THE CLAIMS:

Please amend claims 1, 25, 28, 37 and 46 as follows:

1. (Thrice Amended) An embeddable mounting device comprising:

a first rectangular metal plate member having a first inner surface, a first outer surface, a first length measuring between fifteen (15") and seventeen (17") inches, a first width measuring between seven (7") and nine (9") inches, and a first thickness, said first metal plate member being a one-piece unitary member;

a second rectangular metal plate member having a second inner surface, a second outer surface, a second length of a measurement equal to said first length, a second width of a measurement equal to said first width, and a second thickness, said second metal plate member being a one-piece, unitary member; and

three spacer members rigidly and fixedly secured between said first inner surface and said second inner surface in a manner to form a pair of reinforcing bar and cement receiving cavities and a pair of end cavities between said first and second metal plate members, said spacer members having ~~vertical~~ dimensions to non-movably hold said first and second metal plate members in parallel ~~and vertical~~ relationship with each other such that when said first and second metal plate members simultaneously contact a planar surface said first and second metal plate members are both perpendicularly oriented to said planar surface, and in a manner such that said first and second outer surfaces are spaced apart a spacing distance measuring between seven (7") and eight (8") inches, said pair of reinforcing bar and cement receiving cavities and said pair of end cavities being alignable with reinforcing bar and cement receiving cavities of conventional concrete blocks.

25. (Thrice Amended) A method of permanently affixing a furnishing fixture to a concrete block wall, comprising the steps of:

- a) providing at least one embeddable mounting device comprising:
 - a first rectangular metal plate member having a first inner surface, a first outer surface, a first length, a first width, and a first thickness;
 - a second rectangular metal plate member having a second inner surface, a second outer surface, a second length of a measurement equal to said first length, a second width of a measurement equal to said first width, and a second thickness;
 - a pair of spacer members secured between said first inner surface and said second inner surface in a manner to form at least one reinforcing bar and cement receiving cavity between said first and second metal plate members, said pair of spacer members having ~~vertical~~ dimensions to hold said first and second metal plate members in parallel ~~and vertical~~ relationship with each other such that when said first and second metal plate members simultaneously contact a planar surface said first and second metal plate members are both perpendicularly oriented to said planar surface, and in a manner such that said first and second outer surfaces are spaced apart a predetermined spacing distance; and
 - a third spacer member positioned between said pair of spacer members to create a pair of reinforcing bar and cement receiving cavities that are alignable with said reinforcing bar and cement receiving cavities of conventional concrete blocks;

b) installing said mounting device into said concrete block wall in place of a conventional concrete block, said mounting device being placed into said concrete block wall in a manner such that said reinforcing bar receiving cavity of said mounting device is aligned with at least one reinforcing bar receiving cavity of a said concrete block;

c) providing at least one vertical reinforcing bar that is insertable through one of said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting block;

d) inserting said at least one vertical reinforcing bar into one of said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting device;

e) providing a cementing slurry;

f) pouring said cementing slurry into said reinforcing bar receiving cavities of said concrete block and said reinforcing bar and cement receiving cavity of said mounting device;

g) waiting a period of time sufficient to allow said cementing slurry to harden; and

h) permanently affixing a fixture to one of said plate members of said mounting device.

28. (Thrice Amended) An embeddable mounting device comprising:

a first rectangular metal plate member having a first inner surface, a first outer surface, a first length, a first width, and a first thickness;

a second rectangular metal plate member having a second inner surface, a second outer surface, a second length of a measurement equal to said first length, a second width of a measurement equal to said first width, and a second thickness; and

three rigid spacer members extending between said first inner surface and said second inner surface to form at least two cement cavities, said spacer members having ~~vertical~~ dimensions to non-movably hold said first and second metal plate members in parallel ~~and~~ ~~vertical~~ relationship with each other such that when said first and second metal plate members simultaneously contact a planar surface said first and second metal plate members are both perpendicularly oriented to said planar surface, and in a manner such that said first and second outer surfaces are spaced apart a predetermined spacing distance, said cement cavities being arranged to align with corresponding cement receiving cavities of conventional concrete blocks.

37. (Thrice_Amended) An embeddable mounting device comprising:

a first rectangular metal plate member having a first inner surface, a first outer surface, a first length, a first width, and a first thickness;

a second rectangular metal plate member having a second inner surface, a second outer surface, a second length of a measurement equal to said first length, a second width of a measurement equal to said first width, and a second thickness; and

a pair of rigid spacer members extending between said first inner surface and said second inner surface in a manner to form at least one cement cavity between said first and second metal plate members, said spacer members having ~~vertical~~ dimensions to hold said first and second metal plate members in parallel ~~and-vertical~~ relationship with each other such that when said first and second metal plate members simultaneously contact a planar surface said first and second metal plate members are both perpendicularly oriented to said planar surface, and in a manner such that said first and second outer surfaces are spaced apart a predetermined spacing distance;

a reinforcing bar having a portion extending into said at least one of said cement cavities of said mounting device, such that when said mounting device is placed a top a first concrete block having a pair of conventional cement cavities and below a second concrete block having a pair of conventional cement cavities said reinforcing bar extends into at least one of said cement cavities of each of said first and second concrete blocks.

46. (Thrice_Amended) A method of forming a mounting device for a concrete block wall, comprising the steps of:

providing at least one embeddable mounting device comprising:

a first rectangular metal plate member having a first inner surface, a first outer surface, a first length, a first width, and a first thickness;

a second rectangular metal plate member having a second inner surface, a second outer surface, a second length of a measurement equal to said first length, a second width of a measurement equal to said first width, and a second thickness; and

a pair of rigid spacer members extending between said first inner surface and said second inner surface in a manner to form at least one cement cavity between said first and second metal plate members, said spacer members having ~~vertical~~ dimensions to hold said first and second metal plate members in parallel ~~and vertical~~ relationship with each other such that when said first and second metal plate members simultaneously contact a planar surface said first and second metal plate members are both perpendicularly oriented to said planar surface, and in a manner such that said first and second outer surfaces are spaced apart a predetermined spacing distance, said first and second rectangular metal plate members having peripheral edges with each of said spacer members being spaced inwardly from said peripheral edges;

installing said mounting device into said concrete block wall in place of a conventional concrete block; said mounting device being placed into said concrete block wall in a manner such that said cement cavity of said mounting device is aligned with at least one cement cavity of said concrete block;

providing a cementing slurry; and

pouring said cementing slurry into said cement cavities of said concrete block and said cement cavity of said mounting device.